

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

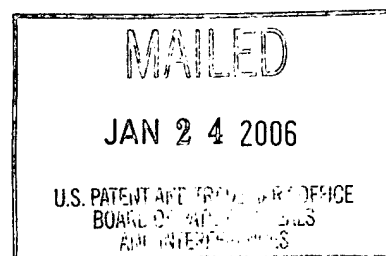
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS DODT, KLAUS KLEINHOFF,
OLIVER SCHURMANN, FRANK GAUTERIN and IVAR VEIT

Appeal No. 2006-0048
Application 09/800,477

ON BRIEF



Before GARRIS, WARREN and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, the appealed claims having been twice rejected, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal:

claims 6 and 7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Dodt et al. (Dodt '306)¹ (answer, pages 3-4); and

claims 1 through 3 and 8 through 21 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (answer, pages 5-11).²

¹ We refer in our opinion to the translation of Dodt '306 prepared for the USPTO by Schreiber Translations, Inc. (October 2003).

² Claims 1 through 3 and 6 through 21 are set forth in the appendix to the brief filed June 17, 2004. Claims 4 and 5, also of record, stand objected to by the examiner as drawn to allowable subject matter but dependent on a rejected base claim (Office action mailed March 17, 2004; page 13). Claims 1 through 21 are all of the claims in the application.

We have considered with the latter ground of rejection the objection to the specification under 35 U.S.C. § 132 (answer, pages 4-5). *See* Manual of Patent Examining Procedure (MPEP) §§ 608.04(c) and 2163.06(II) (8th ed., Rev. 3, August 2005); brief, pages 12-13.

We refer to the answer and to the brief for a complete exposition of the positions advanced by the examiner and appellants.

In order to review the ground of rejection under § 102(b), we first interpret claim 6, on which claim 7 depends, by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the specification, unless another meaning is intended by appellant as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The term in claim 6 at issue is “foil” which appears in the phrase “an acoustically transparent support element comprising at least one layer of perforated foil oriented in a circumferential direction and having centrifugal force resisting tensile strength.” In the context of the claimed “motor vehicle wheel” encompassed by this claim, “the acoustically transparent support element [comprising at least one layer of perforated foil] being coupled to the insert [comprising a ring-shaped sound absorbing material].” Claim 7 further limits claim 6 by requiring “the foil being isotropic.”

Appellants argue that the examiner cannot disregard the term “perforated foil” . . . because . . . [appellants have] not defined the foil thickness in the specification,” and that “it is clear from page 9, lines 7-19 and lines 16-23 of page 10 [of Dodt ‘306] that the tube [configured similarly to a bicycle tube or a tire inner tube] is disclosed as being made of rubber, not foil” (brief, pages 28-29). Appellants do not submit with this argument a definition for the term “foil” in the context of the specification and claims. We find that elsewhere in the brief, appellants contend that the term “foil” as disclosed in the specification can encompass a synthetic material, arguing that “there are many synthetic materials which have the form of a foil such as, e.g., Mylar®,” and submit “that one of ordinary skill in the art would have no difficulty understanding

what is meant by the term foil in the context of the invention” (pages 7 and 21-22).

The examiner contends that the

term “perforated foil” does not distinguish over the [Dodt ‘306] perforated rubber bicycle tube or tire inner tube because 1) the original disclosure provides no special definition for the term which would require a thickness less than that of a rubber bicycle tube or tire inner tube (which is essentially a torodial rubber balloon), and 2) contrary to appellants’ arguments (pp. 21 and 29 of the brief), the dictionary definition of the term “foil” as a “thin flexible sheet of metal” in Webster’s II New College Dictionary³ cannot control the interpretation of the claim term “perforated foil” because requiring the foil to be metal would exclude appellants’ own preferred embodiment of foil made of “synthetic material” (specification paragraph 0061).

We agree with the examiner that the specification does not teach a “thickness” range for the term “foil.” It is disclosed in the specification that as a “support element,” the “foil” is “at least one layer,” can be a “synthetic material,” is “easily handled” and “flexible in all directions,” and is an alternative to “at least one layer of fibers” which can be a “woven mesh” (e.g., [0016]-[0018], [0020], [0033], [0061]). Thus, while there is no thickness range disclosed for the “foil” *per se*, we determine that in the context of the disclosure thereof in the written description in the specification, one of ordinary skill in this art would recognize that the term “foil” is used in its ordinary, dictionary meaning of a very “thin” piece of any material, which dictionary meaning is not limited to “metal” as the examiner contends.⁴

In comparing the claimed motor vehicle wheel thus encompassed by claims 6 and 7 with the motor vehicle wheel as described at page 9, l. 1, to page 11, l. 10, and **Fig. 2**, of Dodt ‘306 as relied on by the examiner, we find no scientific explanation in the statement of the ground of rejection establishing that one skilled in this art would consider the rubber bicycle tube or tire inner tube 5 to be a “foil” and indeed, a “perforated foil.” In the absence of such explanation, we find that the examiner has not pointed out where, as a matter of fact, each and every element of

³ See *Webster’s II New Riverside University Dictionary* 492 (Boston, The Riverside Publishing Company, 1988)

⁴ See generally, *The American Heritage Dictionary Of The English Language* 681 (4th ed., Boston, Houghton Mifflin Company, 2000); *Webster’s Third New International Dictionary Of The English Language Unabridged* 1786 (Philip Babcock Gove, ed., Springfield, Mass., Merriam-Webster Inc. 1993); *Webster’s II New Riverside University Dictionary* 492; *The American Heritage Dictionary, Second College Edition* 519 (Boston, Houghton Mifflin Company, 1982).

the claimed invention, arranged as required by the claims, is described identically in Dodt '306, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984); *see also generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed method if the step that is not disclosed therein "is within the knowledge of the skilled artisan."); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.").

Thus, in the absence of a *prima facie* case of anticipation over Dodt '306 within the meaning of 35 U.S.C. § 102(b), we reverse the ground of rejection of claims 6 and 7.

We now consider the ground of rejection under § 112, first paragraph, written description requirement. It is well settled that the examiner has the burden of making out a *prima facie* case that the *appealed claims* do not comply with this statutory provision, by setting forth evidence or reasons why, as a matter of fact, the written description in appellants' specification in the *present application as it stands of record on appeal* would not reasonably convey to persons skilled in this art that appellants were in possession of the invention defined by claims 1 through 3 and 8 through 21, including all of the limitations thereof, *at the time the present application was filed*. *See generally, In re Alton*, 76 F.3d 1168, 1172, 1175-76, 37 USPQ2d 1578, 1581, 1583-84 (Fed. Cir. 1996), citing *In re Wertheim*, 541 F.2d 257, 262-64, 191 USPQ 90, 96-97 (CCPA 1976). In this respect, it is well further well settled that an original claim is its own written description. *See, e.g., Wertheim*, 541 F.2d at 262, 191 USPQ at 96 (CCPA 1976). In similar manner, in an objection pursuant to 35 U.S.C. § 132, the burden is on the examiner to set forth evidence or reasons why, as a matter of fact, an amendment introduces new matter into the written description of the invention in the *application under examination* in contravention of this statutory provision.

The examiner has pointed to the disclosure “in paragraphs 0029, 0031, and 0033-035” of the present specification in the statement of the objection under 35 U.S.C. § 132. We find that each of these paragraphs were present *per se* in the present application as original filed on March 8, 2001, and were not subsequently amended. See the amendments filed October 10, 2002, and March 31, 2003. Furthermore, original claims 1 through 9 and 14 through 16 in this application were once amended in the amendment filed October 10, 2002, wherein the only amendment to independent claim 1 was the deletion of the word “of” in the fourth clause, and claim 6, originally dependent on claim 1, was amended to be independent and substantially rewritten to read similarly to amended claim 1. We note that claim 6, as well as claim 7 dependent thereon, is not included in the ground of rejection under § 112, first paragraph, written description requirement.

It seems to us that the examiner’s premise for the objection under § 132 and the rejection under § 112, first paragraph, written description requirement, is that the specification in the present application, as it stands on appeal, and appealed claims 1 through 3 and 8 through 21 are directed to “new matter” when compared to the “original disclosure” in the “parent application as originally filed,” on the basis that the *present* “application is a continuation of parent application 08/955,920” and therefore, “the original disclosure is the parent application as originally filed and not this application as originally filed (MPEP 608.04(b)(1))” (answer, page 4, underline emphasis original, and page 5, second full paragraph).

Whether an application as filed can be designated by the USPTO as a “continuation” or a “continuation-in-part” application based on the specification and claims of the new application as filed vis-à-vis the specification and claims of the parent application and other considerations as set forth in MPEP §§ 201.07 and 201.08 (8th ed., Rev. 3, August 2005), is simply an administrative determination which has no affect on the legal determination of compliance of the specification and claims of the new application with 35 U.S.C. §§ 112, first paragraph, written description requirement, and 132 at any point in the prosecution thereof, as is clear from the authority we cite above which involve only the application under examination.

Accordingly, since the examiner has not established a *prima facie* case of non-compliance with 35 U.S.C. §§ 112, first paragraph, written description requirement, and 132, new matter, we reverse these grounds of rejection and objection.

The examiner's decision is reversed.

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